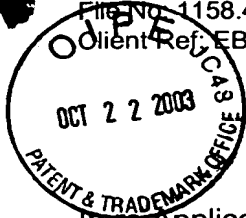


Our Ref: 3350-0089  
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PATENT

AFI 3600  
#15 Appeal  
Reel  
10.24.03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of  
KIGHT, et al.

:  
: Group Art Unit:3627  
:  
: Examiner: J. Kramer  
:  
:

Application No:  
09/892,897

Filed:  
June 28, 2001

For: INTER-NETWORK FINANCIAL SERVICE

RECEIVED  
OCT 27 2003  
GROUP 3600

APPEAL BRIEF

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted (in triplicate) in support of the Notice of Appeal filed August 22, 2003 of the finally rejected claims as set forth in the final Official Action dated May 23, 2003.

I. REAL PARTY IN INTEREST

CheckFree Services Corporation, Reel 012250, Frame 0008.

II. RELATED APPEALS AND INTERFERENCES

NONE.

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### **III. STATUS OF CLAIMS**

Claims 1-52 are pending in this application, of which claims 1 and 27 are independent. Each of claims 1-52 is subject to appeal.

### **IV. STATUS OF AMENDMENTS**

An after final Amendment under 37 CFR §1.116, correcting an inadvertent editorial error in claim 10, was filed on July 23, 2003. Pursuant to the Advisory Action issued August 6, 2003, the after final Amendment has been entered. A Request for Reconsideration was also filed on March 20, 2003.

### **V. SUMMARY OF INVENTION**

The invention will be summarized with reference to the preferred embodiment(s)/implementation(s) shown in Figures 3-20C and described in the related specification text on pages 26-76 (see in particular the drawings beginning with Figure 7 and the text beginning on page 33).

According to the present invention a payment request generated in a first one 200A of multiple payment networks is completed by a second payment network 200B. The first network 200A has a first payment service provider 705A and is associated with multiple payers and payees, and the second payment network 200B has a second payment service provider 705B and is also associated with multiple payers and payees. The first and second payment service provider's work together to provide the service of making a payment on behalf of a payer associated with one payment network 200A to a payee associated with another payment network 200B.

According to the inventive technique, each of the first and the second payment networks 200A and 200B comprises multiple devices capable of communicating with one another. The devices could all be the same type of device, or different types of devices. For example, a device could be a personal digital assistant (PDA), a cellular,

digital, or traditional telephone, a personal computer, a high powered workstation, a server, a sophisticated mainframe computer, or any type device capable of transmitting and receiving the communications described herein. The communications could be voice communications, digital data communications, or analog data communications. Furthermore, one or more of multiple communications to achieve an inter-network payment could be a different type communication than other communications to achieve the inter-network payment. Each of the first and second payment service providers 705A and 705B serve to implement payments directed by payers associated with the payment network with which the payment service provider is associated. Each of the first and second payment service providers 705A and 705B also communicates with others to implement inter-network payments.

According to the method, a request to make a payment on behalf of a payer is received at the first payment service provider 705A. The payer could be associated with the first payment network 200A, or could associated with another payment network 200A. The request is to make a payment to a payee that is not associated with the first payment network. The payment could be any type payment, including a payment of a bill, a payment of an invoice, a gift payment, a person-to-merchant payment, or a person-to-person payment. The payment request could include information informing the first payment service provider 705A that the payee is not associated with the first payment network 200A, or the first payment service provider 705A could determine that the payee is not associated with the first payment network 200A. This could include analyzing information contained in the request. The payment request preferably includes, at least, information identifying the payee and an amount for payment. Information identifying the payee could be any type of information identifying a payee, such as, for example, the payee's name, address, or e-mail address. The payment request could include information in addition to identifying information and an amount. Furthermore, the payment request could only include information identifying the payee.

In such a case, a payment amount is obtained later.

The first payment service provider 705A transmits a request to determine the payment network with which the payee is associated. This transmitted request preferably includes any identifying information included in the received payment request, though it could include only a portion of this information, or it could include information other than that included in the received payment request. That is, the first payment service provider 705A could add to or modify the information identifying the payee. In response to the transmitted request, the first payment service provider receives information indicating that the payee is associated with the second payment network 200B. The first payment service provider 200A then transmits a payment instruction to the second payment service provider 705B. This payment instruction is an instruction for the second payment service provider 705B to make a payment to the payee.

According to a beneficial aspect of the present invention, the received information indicating that the payee is associated with the second payment network 200B includes a unique identifier that identifies the payee to the second payment service provider 705B. The first payment service provider 705A includes this unique identifier in the payment instruction transmitted to the second payment service provider 705B, thus enabling the second payment service provider 705B to unambiguously identify the payee upon receipt of the payment instruction.

According to a further and especially beneficial aspect of the present invention, first payment service provider 705A stores the received information indicating that the payee is associated with the second payment network 200B. The stored information includes the unique identifier. In this manner, the first payment service provider 705A has a record of the association of the payee with the second payment network 200B and need not again determine the payment with which the payee is associated. According to this further aspect, the first payment service provider 705A receives a

second payment request to pay the payee. The first payment service provider retrieves the stored information indicating that the payee is associated with the second payment network 200B. The first payment service provider 705A then transmits a second payment instruction to the second payment service provider 705B including the retrieved unique identifier.

Still further, the received payment request is a request to make a payment on behalf of a first payer, and the second request is a request to make a payment on behalf of either the first payer or a second payer. Thus, the stored information indicating that the payee is associated with the second payment network 200B is available for retrieval any time a payment request directed to the payee is received by the first payment service provider 705A, no matter the identity of the payer.

According to another aspect of the present invention, the request to determine the payment network with which the payee is associated is transmitted to an inter-network directory provider 301. The inter-network directory provider 301 is preferably not associated with any one of the multiple payment networks, though it could be. The inter-network directory provider 301, among other functions, aids in determining the payment network 200B with which the payee is associated.

According to a further aspect, the inter-network directory provider 301 identifies one or more of the multiple payment networks as candidate payment networks with which the payee may be associated. This determination is made based upon the transmitted request. Preferably, this determination is made based upon information identifying the payee, discussed above, contained in the transmitted request. A candidate network is a network with which the payee may be associated. That is, according to this further aspect of the present invention, the inter-network directory provider 301 does not conclude that the payee is associated with the second payment network 200B, but rather only identifies candidate payment networks. Another makes this conclusion. The inter-network directory provider 301 could identify a single payment

network, multiple payment networks, or no payment networks. The inter-network directory provider 301 transmits information indicating the one or more identified candidate payment networks to the first payment service provider 705A. According to this further aspect, the inter-network directory provider 301 identifies the second payment network 200B as a candidate payment network.

Still further, according to the present invention, the first payment service provider 705A transmits a request to the second payment service provider 705B to determine if the payee is associated with the second payment network 200B. This is a request specifically seeking to determine if the payee is associated with the second payment network 200B. The received information indicating that the payee is associated with the second payment network 200B is received in response to this request transmitted to the second payment service provider 705B by the first payment service provider 705A.

And even further, in accordance with the present invention, the information received from the second payment service provider 705B indicating that the payee is associated with the second network 200B includes information identifying the payee as one candidate payee and information identifying at least one other payee as another candidate payee. The second payment service provider 705B identifies the payee as one candidate payee, and another payee as another candidate payee. This identification is transmitted to the first payment service provider 705A. That is, the information received from the second payment service provider 705B, according to this particular aspect of the present invention, is not a conclusion that the payee is associated with the second network 200B. Rather, similar to the identification of candidate payment networks discussed above, the second payment service provider 705B merely identifies candidate payees that are associated with the second network 200B that may be the intended payee. After receipt of this information identifying candidate payees, a determination is made, based upon one or both of information included in the request transmitted to the second payment service provider 705B and

the received information identifying the one and the other candidate payees, that the one candidate payee, and not the other candidate payee, is the intended payee.

According to another aspect of the present invention, the payment request is received from the payer. After the first payment service provider 705A receives, from the second payment service provider 705B, the information identifying the one and the other candidate payees, this information is transmitted to the payer (e.g., represented by device 710A). The payer then selects the correct payee from the candidate payees and transmits the selection to the first payment service provider 705A. The first payment service provider 705A then transmits the payment instruction, to the second payment service provider 705B, as discussed above.

According to another aspect of the present invention, the first service provider 705A selects the correct payee from the candidate payees.

According to yet another aspect of the present invention, the information received from the inter-network directory provider 301 includes information identifying a third payment network as a candidate payment network. The third payment network has a third payment service provider. The first payment service provider transmits a request to the third payment service provider to determine if the payee is associated with the third network, as described above in relation to the request transmitted to the second payment service provider. According to this aspect, the third payment service provider determines that the payee is not associated with the payee, and transmits this determination to the first payment service provider. Thus, whenever multiple candidate payment networks are returned by the inter-network directory provider 301, the first payment service provider 705A transmits requests to payment service providers associated with the candidate payment networks until the correct payment network is determined.

According to another beneficial aspect of the present invention, communications between and among the multiple networks can be secured. The inter-network directory

301 provider stores information indicating if a given payment service provider requires secured communications. A decision on requiring secured communications is made by each payment service provider. We'll assume that the second payment service provider 705B requires secured communications. Information indicating this fact is returned with the information identifying the second payment network 200B as a candidate payment network. The first payment service provider 705A accesses a certificate authority 701 to retrieve an encryption key associated with the second payment service provider 705B. Encryption keys are well understood by one skilled in the art. Further, the certificate authority 701 could be located at, or be a part of, the inter-network directory provider 301. The request transmitted to the second payment service provider 705B is encrypted with the encryption key prior to transmission.

According to an especially beneficial aspect of the present invention, the information received from the second payment service provider 705B, in response to the request to determine if the payee is associated with the second payment network 200B, is a positive declaration that the payee is associated with the second payment network 200B. That is, the second payment service provider 705B, according to this especially beneficial aspect, concludes that the payee is associated with the second network 200B and transmits an indication of such to the first payment service provider 705A.

According to yet another aspect of the present invention, the inter-network directory provider 301 stores information to facilitate inter-network payments. This stored information includes information associated with the multiple payment service networks 200A and 200B and information indicating a network path over which to communicate with a certificate authority 701, discussed above. The stored information associated with each of the multiple payment networks includes at least one of several types of information. The types of information include, but are not limited to, information indicating a country in which a payment service provider is located, information



identifying a network path over which to communicate with a payment service provider, information indicating types of financial transactions supported by a payment service provider, information indicating secured communications requirements of a payment service provider, information identifying a treasury service provider 719A or 715B associated with a payment service provider, information identifying a deposit account associated with a payment service provider, information identifying a processing model associated with a payment service provider, and information identifying a settlement method associated with a payment service provider.

According to an advantageous aspect of the present invention, the information stored by the inter-network directory provider 301 is accessed and searched by the first payment service provider 705A. The stored information is retained at the inter-network directory provider 301. This searching of the information stored at the inter-network directory provider 301 is to identify the payment network with which the payee is associated.

According to another advantageous aspect of the present invention, the information stored by the inter-network directory provider 301 is downloaded and searched by the first payment service provider 705A. Thus, a copy of all or a portion of the information stored at the inter-network directory provider 301 is downloaded by the first payment service provider 705A. The downloaded information is then searched by the first payment service provider 705A to identify the payment network with which the payee is associated.

According to yet another beneficial aspect of the present invention, the inter-network directory provider 301 stores information for each of the multiple payment networks indicating associations between its payment service provider and its payees. This information identifies payees known to a payment service provider. The payment network with which the payee is associated is determined by the inter-network directory provider 301, based upon the request transmitted to the inter-network directory provider

301 and this stored information. The inter-network directory provider 301 transmits the information indicating that the payee is associated with the second payment network 200B to the first payment service provider 705A. According to this aspect, the information indicating that the payee is associated with the second payment network 200B is a determination that the payee is associated with the second payment network 200B, similar to the discussion above. Thus, according to this aspect, a request to the second payment service provider 705B is not required or necessary, though this operation could certainly be performed.

According to another aspect of the present invention, the request to determine the payment network with which the payee is associated is transmitted to the second payment service provider 705B, and the received information indicating that the payee is associated with the second payment network 200B is received from the second payment service provider 705B. According to this aspect, the second payment service provider 705B makes a determination if the payee is associated with the second payment network 200B. Thus, according to this aspect, the request to determine the payment network with which the payee is associated is transmitted directly to a payment service provider, and that payment service provider makes a determination if the payee is associated with the same payment network with which that payment service provider is associated. Prior to transmission of the request to the second payment service provider 705B, the first payment service provider 705A may have some information indicating that the payee may be associated with second payment network 200B, or may have no information indicating that the payee is associated with the second payment network 200B. Further, multiple such transmissions could be made by the first payment service provider 705A to different payment service providers associated with different ones of the multiple payment networks. This process could thus continue until the correct payment network is determined.

According to another advantageous aspect of the invention, the first payment

network 200A serves as a gateway to other ones of the multiple payment networks. That is, a payment request generated in one payment network is passed to at least one intermediate network, which then passes it on to the payment network with which the payee is associated. According to this aspect, the payment request is received from a third payment service provider associated with a third payment network. The payer, in this aspect, is also associated with the third payment network, though the payer could be associated with another payment network other than the first, second, or third payment networks.

In another beneficial aspect of the present invention, the payment request is structured according to a first message set, and the request to determine the payment network and the payment instruction are structured according to a second message set other than the first message set. Preferably, the second message set is a common message set intended to be used in making inter-network payments. Therefore, a payment service provider can communicate with payers according to any message set desired by the payment service provider, and in turn communicate with other payment service providers, the inter-network directory provider, and the certificate authority according to the common message set.

According to another aspect of the present invention, funds are transferred from an account associated with the payer to an account associated with the first payment service provider 705A, funds are transferred from an second account associated with the first payment service provider 705A to an account associated with the second payment service provider 705B, and funds are transferred from an account associated with the second payment service provider 705B to an account associated with the payee. Thus, with these three funds transfers, the payer makes payment to the payee with the services of the first and the second payment service providers 705A and 705B. Preferably, each of these accounts is a deposit account maintained at one or more financial institutions. However, one or more of these accounts could be another type

account, such as a stored value account or a credit account. Also, the accounts associated with the first payment service provider 705A could be the same account, and the accounts associated with the second payment service provider 705B could be the same account. Furthermore, preferably none of the funds transfers are dependent upon any of the other funds transfers, though one or more could be. Especially beneficial, any one or all of these transfers can be electronic funds transfers. When each of the transfers is an electronic funds transfer, the payment from the payer to the payee is a completely electronic transaction. It will be recognized that the present invention enables a payment from a payer associated with a first payment network 200A to a payer associated with a second network 200B to be made electronically.

In yet another aspect of the present invention, the first payment service provider 705A transmits remittance advice associated with the payment to the second payment service provider 705B. The remittance advice could be a simple indication of the identity of the payer, or could be detailed information associated with a bill or statement upon which the payment is being made. Furthermore, the remittance advice could be generated by the first payment service provider 705A, or could be generated by the payer and transmitted to the first payment service provider 705A. The remittance advice could be transmitted at the same time the payment instruction is transmitted, or at another time. The second payment service provider 705B transmits the remittance advice to the payee.

According to a further aspect, the remittance advice transmitted from the first payment service provider 705A to the second payment service provider 705B is structured according to a first message set, while the remittance advice transmitted from the second payment service provider 705B to the payee is structured according to a second message set. As will be understood, with reference to the discussion above on message sets, the first message set could be a common message set directed to inter-network payments, and the second message set could be any message set by which a

payment service provider communicates with payees associated with the same payment network with which payment service provider is associated.

According to yet another beneficial aspect of the present invention, the second payment service provider 705B determines if the payment instruction will be accepted. That is, if the second payment service provider 705B will make payment to the payee. The results of this determination are transmitted to the first payment service provider 705A.

Preferably, the first payment service provider 705A propagates this determination to the payer.

## **VI. ISSUES**

Whether claims 1-52 are obvious, under 35 U.S.C. § 103(a), over Thomas et al. (U.S. Patent No. 6,173,272).

Whether claims 1, 5-10, 27 and 31-36 are obvious over claims 53-72 of co-pending U.S. Application S/N 09/984,568 for purposes of double patenting under the judicially created doctrine of obviousness-type double patenting.

## **VII. BRIEF DESCRIPTION OF THE PRIOR ART REFERENCE**

Thomas et al. (U.S. Patent No. 6,173,272), in column 4, discloses that the TTP determines, based on the unique ID, the name and address of the payee and the RTN of the second bank, and uses this information to transfer the funds, i.e. to complete the ACH transfer of the funds, to the payee's account at the second bank (see also Figure 2A and column 14, line 66, through column 15, line 17). As shown in Figure 2A, there are no transmissions of payment instructions from the payer bank to the payee bank.

Rather, in Thomas, the transmittal of the payment instruction from the payer bank (i.e. which the Examiner contends to be a first payment service provider) is only to the TTP (not to the payee bank). Furthermore, this transmittal occurs prior to the information, which indicates that the payee is associated with the payee bank (i.e. which

the Examiner contends to be a second payment service provider) even being determined by the TTP (i.e. before the identity of the payee's bank is determined by TTP and without the payee's bank being known to the payer's bank.

As disclosed in column 13, lines 41-62, Thomas explicitly teaches against allowing information indicating that the payee is associated with the second bank (or a second payment network), to be received by or otherwise disclosed to the first bank (or a first payment service provider). Indeed, in the paragraph bridging columns 3 and 4, Thomas discloses that his objective is to utilize the unique ID to avoid the disclosure of such information to the payer or first bank.

### **VIII. THE REJECTION**

In a first substantive Official Action issued on December 20, 2002, claims 1-52 stood rejected under 35 U.S.C. § 103(a) as obvious over Thomas et al. (U.S. Patent No. 6,173,272). Claims 1, 5-10, 27 and 31-36 stood provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 53-72 of co-pending U.S. Application S/N 09/984,568.

In the final Official Action issued May 23, 2003, the rejections are maintained, notwithstanding the traversal arguments submitted in the Request for Reconsideration filed on March 20, 2003.

In the Advisory Action issued on August 6, 2003, the rejection is maintained notwithstanding the further traversal arguments submitted in the remarks of the Amendment filed on July 23, 2003 in response to the final Official Action. The sole support asserted in that Advisory Action for maintaining the rejections is that "examiner finds the arguments non-persuasive. Applicant incorporated the traversal argument file[d] on March 20, 2003 the Examiner directs Applicant to the office action filed on 5/23/03 for details on Examiner's position".

### **IX. GROUPING OF CLAIMS**

Claims 1-52 are pending in this application. Claims 1-52 are finally rejected and subject to this appeal.

Rejected claims 1 and 27 are independent. Accordingly the various claimed embodiments/implementations of the invention are defined within groupings of claims (i) 1-26 and (ii) 27-52. However, the claims of each group do not stand or fall together. Each of claims 1, 3, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 22, 24, 25, 26, 27, 29, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 48, 50, 51, and 52 recite features which form an independent basis for allowance. Hence, claims 1, 2, 4-5, 20-21, and 23 stand and fall together; claims 27, 28, 30-31, 46-47 and 49 stand and fall together; and each of claims 3, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 22, 24, 25, 26, 29, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 48, 50, 51, and 52 stands and falls alone.

### **X. ARGUMENT**

Claims 1-52 stand finally rejected under 35 U.S.C. § 103(a) as obvious over Thomas et al. (U.S. Patent No. 6,173,272). Claims 1, 5-10, 27 and 31-36 also stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 53-72 of co-pending U.S. Application S/N 09/984,568. Appellants respectfully traverse the rejections based on the prior art applied against the claims now pending on appeal.

As discussed below in detail, it is respectfully submitted that the final rejection lacks the requisite supporting factual basis and/or reasonable rationale, and accordingly cannot be understood. Further still, it is respectfully submitted that the art applied in rejecting the claims neither teaches nor suggests the claimed invention. It is also respectfully submitted that recited limitations have been ignored and the relied upon art has been construed in a manner inconsistent with its own teaching and the rejection is

at best based on an improper hindsight reconstruction of the claimed invention.

## 1. LACK OF DUE PROCESS IN THE EXAMINATION

Due process of law requires that applicants receive a full, fair and impartial hearing. In the prosecution of a patent application, this requires that Official Actions, such as those rejecting claims, be made on the basis of objective evidence and sound reasoning. Official Actions should not be made arbitrarily or based on unsupported speculation and the like. Due process also mandates a fair opportunity to be heard. Hence, in the prosecution of a patent application, not only should applicants be given a chance to respond to Official Actions setting forth the basis for rejection of the claims, but the arguments presented in such a response should be given due consideration prior to final Action being taken. See for example, In re De Blauwe, 222 USPQ 191 (Fed. Cir. 1984); In re Ludtke, 169 USPQ 563 (CCPA 1971).

### A. Clearly Defined Issue for Appeal

MPEP §707.07 requires that "before a final rejection is in order a clear issue should be developed between the Examiner and applicant." Indeed, the Manual states that "the references should be fully applied" (emphasis added), so as to deal justly with the applicant as well as the public. The Manual goes on to state that "present practice does not sanction hasty and ill-considered...rejections". "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end." "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible..."(emphasis added).

In relevant part, MPEP § 707.07(g) instructs an Examiner that "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression" (emphasis



added). Omnibus rejections are to be avoided. Hence, a plurality of claims should never be grouped together in a common rejection, unless that rejection is applicable to all the claims in the group. (See MPEP §707.07(d))

The case history evidences that the Examiner has presented an omnibus rejection of the claims in the final Official Action. The omnibus rejection completely ignores these numerous limitations recited in both the pending independent and dependent claims. Furthermore, the Examiner has persistently failed to properly consider detailed arguments presented in traversal of the prior art rejections, has failed to provide any reasonable or understandable basis for rejection or maintaining the rejection in view of the points explicitly raised in response to Official Actions, and has not even attempted to answer questions or provide clarification sought by Applicants' representative which is necessary in order to understand the positions taken by the Examiner. For these reasons, it is respectfully submitted that a "clear issue" has never been reached with respect to the rejection of the claims.

As noted above, MPEP Section 706.07 clearly requires that "before final rejection is in order, a clear issue should be developed between the examiner and applicant." Indeed, by making the action of May 23, 2003 final, applicants have clearly not been provided with the "cooperation of the Examiner", required by MPEP Section 706.07, in defining the invention by claims that will give applicants the patent protection to which they are "justly entitled." By failing to provide the requested clarification as to the rationale for the rejection (particularly in view of the omnibus nature of the rejection), Applicants' representative has been placed in a position of being forced to disprove a negative (i.e. that the claims are not obvious over the applied prior art or in view of one of the assignee's co-pending applications), without the ability to form a reasonable understanding of why the claims are being rejected.

In the Advisory Action of August 6, 2003, it is asserted that "examiner finds the arguments non-persuasive. Applicant incorporated the traversal argument file[d] on

March 20, 2003 the Examiner directs Applicant to the office action filed on 5/23/03 for details on Examiner's position". This response ignores the fact that additional the traversal was not limited to the arguments previously submitted and incorporated by reference, but also included new additional arguments. Hence, the Examiner's assertion, in and of itself, evidences the questionable basis on which the claims have been rejected and is an admission of the impropriety of the final Official Action.

Had the Examiner responded to the Requests for Reconsideration by providing reasonably understandable arguments rebutting the traversal arguments presented in responses to the prior non-final Official Action and the final Official Action, and then maintained the rejection of the claims on the same basis as previously asserted, an issue would have been reached. However, the Examiner has instead apparently chosen to ignore the detailed traversal arguments, and simply maintain a position which cannot be reasonably understood or supported.

Thus, the issues in this case remain unfocused and the basis for rejection remains unclear.

B. Fair Hearing

Notwithstanding the detailed traversal arguments presented by the Applicants' representative, the Examiner has not provided any objective evidence to contradict the evidence presented for allowance in the prior responses. Furthermore, the Examiner has chosen not to address questions regarding the rejection raised by Applicants' representative or provide requested clarifications necessary to form reasonable understanding of the Examiner's asserted positions. Instead, the Examiner appears to have simply ignored the objective evidence, and maintain an unsupported position contrary thereto.

Thus, the Examiner's rejection of the claims in this case can only be viewed, at best, as arbitrary, since the rejections are unsupported by either the objective evidence or any reasonable rationale presented within the record.

### C. Opportunity To Be Heard

As discussed above, the Examiner sole basis for maintaining the rejection notwithstanding the new traversal arguments presented in the after final response filed on July 23, 2003 is that "examiner finds the arguments non-persuasive. Applicant incorporated the traversal argument file[d] on March 20, 2003 the Examiner directs Applicant to the office action filed on 5/23/03 for details on Examiner's position". However, new traversal arguments, which the Examiner acknowledges that he has not considered, were presented in the response of July 23.

Furthermore, the record is replete with evidence of the Examiner continued failure throughout the prosecution of this case to address detailed arguments presented in traversal of the rejections and specific requests for clarification of the positions asserted, which are necessary to forming a reasonable understanding of the basis for rejections or maintaining the rejections in view of the traversal arguments presented in response to Official Actions. Indeed, the Examiner has not even attempted to answer questions explicitly or implicitly raised by Applicants' representative.

For example, in response to the initial Official Action on the merits it was noted that "the basis for the obviousness-type double patenting rejection has not been argued on a claim-by-claim basis". Yet no claim-by-claim analysis is provided in the final Official Action to correct this deficiency.

It is also noted in the response to the initial Official Action that "Thomas, as for example shown in Figure 2A, lacks multiple payment networks, with each of the networks having a plurality of associated payors and payees. Hence, Thomas has no need to transmit a request to determine which of multiple payment networks is associated with a payee to whom a payor associated with the first payment network wishes to direct the payment", as required by claim 1. However, here again, there is nothing offered in the final Official Action in rebuttal of the noted deficiency in the initial Official Action.

It is additionally noted in response to the initial Official Action that "Thomas lacks any teaching or suggestion of the payee bank receiving a payment instruction transmitted by the payer bank. Since this would require that information be made available to the payer bank, which Thomas explicitly teaches should not be made available to the payer bank, having the second payment processing station required by claim 27 would also be inconsistent with Thomas' teaching and render Thomas unable to meet its primary objective." Once again, the final Official Action fails to correct the noted deficiency in the initial Official Action.

Rather, in the Response to Arguments in the final Official Action the Examiner fails to even address these points, choosing instead to limit the response to the failure of the prior Official Action to present the factual determinations required by Graham v. John Deere Co. of Kansas City, 148 USPQ 459 (1966).

In response to the final Official Action on the merits it was noted that "In this particular case, the Examiner has apparently failed to recognize the fact that the prior art could not be modified so as to result in the combination defined by the claims, without contradicting the applied art's own teachings and rendering it unable to meet its primary objective. The prior art not only fails to suggest the desirability of the Examiner's proposed modification, but in fact teaches against them. Thus, the applied art would not have made the proposed modification obvious." It was also noted that "numerous other distinguishing features and limitations recited in the respective dependencies of independent claims 1 and 27 are not addressed and have apparently been either completely or effectively ignored during the examination of this application." However as noted above, the only response offered in the Advisory Action to these deficiencies is that "examiner finds the arguments non-persuasive. Applicant incorporated the traversal argument file[d] on March 20, 2003 the Examiner directs Applicant to the office action filed on 5/23/03 for details on Examiner's position"

For these reasons, it is respectfully submitted that applicants have not been

given the "opportunity to be heard".

Based on the above, it is respectfully submitted that applicants have been deprived of their rights to due process under law due to the Examiner's persistent rejection of the claims, without any reasonable basis to do so and in a manner which effectively denies applicants their right to be heard, as well as the Examiner's failure to comply with the mandates of MPEP 706.

## 2. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE

In rejecting claims under 35 U.S.C. §103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is required to make the factual determination set forth in Graham v. John Deere Co. of Kansas City, 148 USPQ 459 (1966), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine the prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or inference in the prior art as a whole. It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious.

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986)). In determining the issue of obviousness, we must look to the collective teachings of the references relied upon and to whether the hypothetical person of ordinary skill in the art, familiar with such teachings would have

found it obvious to make a corresponding structure or process to that being claimed (See In re Fritch, 23 USPQ 1780 (Fed. Circ. 1992)).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Obviousness cannot be properly established by simply showing that each claimed element may be found somewhere in the prior art (See Hartness International, Inc. v Simplimatic Engineering Co., 2 USPQ 2d 1826 (Fed. Circ. 1987)).

Simplicity and hindsight are not proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). The mere possibility that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. In the absence of such a suggestion the basis for the rejection can only be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

Additionally, the issue is not whether it is within the skill of the art to make the proposed modifications, but rather if one skilled in the art, on consideration of the reference(s), would have found it obvious to do so. It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Gordon, 221 USPQ 1125 (Fed. Circ. 1984), and In re Keller, 208 USPQ 817 (CCPA 1981)).

It is respectfully submitted that, in this case, the asserted conclusion of obviousness is not based on what the prior art shows, teaches or suggests. Furthermore, it is further respectfully submitted that there is nothing within the applied art teachings that would suggest the Examiner's proposed modification to arrive at the invention claimed in the present application. Rather, the applied prior art lacks any suggestion of the combination recited in each of the independent claims, as well as any suggestion that such a

combination of features could or would be beneficial.

Simplicity and hindsight are not proper criteria for resolving obviousness (See In re Wamer, supra). Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

Indeed, MPEP §707.07 cautions Examiners that "the references should be fully applied" (emphasis added), so as to deal justly with the applicant as well as the public. Furthermore, as set out in MPEP § 707.07(g), the Examiner is instructed that "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression" (emphasis added). Omnibus rejections are to be avoided. Hence, a plurality of claims should never be grouped together in a common rejection, unless that rejection is applicable to all the claims in the group. (See MPEP §707.07(d))

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985); In re Piasecki, 223 USPQ 785 (Fed. Cir. 1984).

The limitations required by the claims cannot be ignored. See In re Wilson, 165 USPQ 494 (CCPA 1970). All claim limitation, including those which are functional, must be considered. See In re Oelrich, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 170 USPQ 330 (CCPA 1971).

The Examiner must provide sufficient factual basis or rationale as to how features of the invention recited in the claims are taught or suggested in the applied art. Uniroyal,

Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). That is, objective evidence must be presented by the Examiner in support of the rejection. Without such support, the rejection is improper per se.

It is respectfully submitted that the Examiner has failed to establish a prima facie case for the rejections based on obviousness and on obviousness type double patenting. More particularly, the Examiner has failed to provide objective support or reasonable rationale for the rejections, has ignored limitations recited in the claims, and has applied art in a manner inconsistent with its teachings.

Rejection of Claims 1-52 under 35 USC §103(a)

Claims 1-52 stand finally rejected under 35 U.S.C. § 103(a) as obvious over Thomas et al. (U.S. Patent No. 6,173,272)

In both the initial Official Action on the merits and the final Official Action, the Examiner rejects the 52 claims as obvious based on an omnibus argument presented with reference to (1) column 3, line 65, through column 4, line 4, (2) column 4, lines 35-55, (3) column 7, line 65, through column 8, line 5, and (4) column 8, lines 47-49 and 56-57, of Thomas.

In responding to specific questions relating to the omnibus form of the rejection raised in response to the initial Official Action, the Examiner (in the Response to Arguments present on page 4 of the final Official Action) the sole response offered by the Examiner is "Examiner believes that the rejection is in fact applicable to all the claims of the group." However, the Examiner provides no support for this bald assertion.

For example, it is noted in the response to the initial Official Action on the merits that, because Thomas (as for example shown in Figure 2A) lacks multiple payment networks with each of the networks having a plurality of associated payors and payees, Thomas has no need to transmit a request (as required by claim 1) to determine which



of multiple payment networks is associated with a payee to whom a payor associated with the first payment network wishes to direct the payment. However, the Examiner while maintaining the rejection in the final Official Action, does not offer any rationale in rebuttal.

Furthermore, independent claim 1 recites a method for making payments across multiple payment networks. Included in these multiple payment networks is a first payment network having a first payment service provider and a plurality of associated payers and payees, and a second payment network having a second payment service provider and a plurality of associated payers and payees.

As now understood, the Examiner construes the claim such that the recited multiple payment networks correspond to networks, each of which includes an individual bank and its banking customers who are payers and payees. Thus, according to the Examiner, the first payment network includes a first bank (which the Examiner considers to be a first payment service provider) and its associated bank customers (who the Examiner considers to be a plurality of associated payers and payees), and the second payment network includes a second bank (which the Examiner considers to be a second payment service provider) and its associated bank customers (who the Examiner considers to be a plurality of associated payers and payees).

According to the method of claim 1, a request to make a payment, on behalf of a payer, to a payee not associated with the first payment network is received at the first payment service provider.

As understood, the Examiner views this recital as being met by the first bank receiving a request to make a payment on behalf of one of its associated bank customers (a payer customer) to a payee which is not one of its associated bank customers (i.e. a customer associated with a second bank).

According to the method of claim 1, a request of the first payment service provider is transmitted to determine a payment network within the multiple payment

networks with which the payee is associated.

As understood, the Examiner (relying on the disclosure in column 4, lines 35-55, of Thomas) views this recital as being met by the first bank (i.e. the payer's bank) transmitting a request with the payees unique ID to the TTP, which identifies the RTN of the second bank (i.e. the payee's bank) and thereby identifies a second payment network within the multiple bank networks with which the payee is associated.

According to the method of claim 1, information indicating that the payee is associated with the second payment network is received [implicitly by the first payment service provider (see below)].

As understood, the Examiner views this recital as being met by the disclosure in column 4, lines 35-55, and column 8, lines 47-49, and 56-57, of Thomas.

However, as disclosed in column 4, the TTP determines, based on the unique ID, the name and address of the payee and the RTN of the second bank, and uses this information to transfer the funds. Hence, in Thomas there is no, and there is no need for, the receipt (let alone receipt by the first payment service provider) of information indicating that the payee is associated with the second bank (i.e. that the payee is associated with a second payment network). It appears that the omnibus rejection presented in the final Official Action completely ignores this limitation.

According to the method of claim 1, a payment instruction from the first payment service provider is also transmitted to the second payment service provider to make the payment to the payee. Implicit in this recital is (i) that the transmittal of the payment instruction from the first payment service provider occurs after the information, which indicates that the payee is associated with the second payment network, is received, and (ii) that the information indicating that the payee is associated with the second payment network be received by the first payment service provider. Otherwise, the identity of the payee's payment service provider would be unknown to the first payment service provider.

Here again, as understood, the Examiner views this recital as being met by the disclosure in column 4, lines 35-55, and column 8, lines 47-49, and 56-57, of Thomas.

However, as disclosed in column 4 and discussed above, the TTP determines, based on the unique ID, the name and address of the payee and the RTN of the second bank, and uses this information to complete the ACH transfer of the funds to the payee's account at the second bank (see Figure 2A and column 14, line 66, through column 15, line 17). Hence, in Thomas there is no, and there is no need for, transmission of a payment instruction from the first bank (or from a first payment service provider) to the second bank (or to a second payment service provider) to make the payment to the payee. Indeed, as is clear from Figure 2A, there are no transmissions of payment instructions from the payer bank to the payee bank. Rather, in Thomas, the transmittal of the payment instruction from the payer bank (i.e. which the Examiner contends to be a first payment service provider) is only to the TTP (not to the payee bank). Furthermore, this transmittal also occurs prior to the information, which indicates that the payee is associated with the payee bank (i.e. which the Examiner contends to be a second payment service provider) even being determined by the TTP (i.e. before the identity of the payee's bank is determined by TTP and without the payee's bank being known to the payer's bank.

As disclosed in column 13, lines 41-62, Thomas in fact teaches against allowing information indicating that the payee is associated with the second bank (or a second payment network), to be received by or otherwise disclosed to the first bank (or a first payment service provider). Indeed, in the paragraph bridging columns 3 and 4, Thomas discloses that his objective is to utilize the unique ID to avoid the disclosure of such information to the payer or first bank.

Here too, it appears that the omnibus rejection presented in the final Official Action completely ignores these limitations. Additionally, the application of Thomas as proposed is inconsistent with Thomas' own explicit teachings and would render Thomas

unable to accomplish its primary objective.

Independent claim 27 is directed to a system for making payments across multiple payment networks including a first payment network having a plurality of associated payers and payees, and a second payment network having a plurality of associated payers and payees. The system includes a first payment processing station associated with the first payment network configured to:

- 1) receive a request to make a payment on behalf of a payer to a payee not associated with the first payment network,
- 2) to transmit a request to determine a payment network within the multiple payment networks with which the payee is associated,
- 3) to receive information indicating that the payee is associated with the second payment network, and
- 4) to transmit a payment instruction to the second payment network to make the payment to the payee.

As has been discussed in detail above, Thomas lacks any teaching or suggestion of the payer bank receiving information indicating that the payee is associated with the payee or second bank (or a second payment network), or transmitting a payment instruction to the payee bank (or a second payment network) to make the payment to the payee. In fact, providing the first payment processing station required by claim 27 would be inconsistent with Thomas' teaching and render Thomas unable to meet its primary objective.

The claim 27 system also includes a second payment processing station associated with the second payment network which is configured to receive the transmitted payment instruction.

Here again, as has been discussed in detail above, Thomas lacks any teaching or suggestion of the payee bank receiving a payment instruction transmitted by the payer bank. Since this would require that information be made available to the payer

bank, which Thomas explicitly teaches should not be made available to the payer bank, having the second payment processing station required by claim 27 would also be inconsistent with Thomas' teaching and render Thomas unable to meet its primary objective.

Thus, the Examiner has failed to make the factual determinations required by Graham v. John Deere Co. of Kansas City, 148 USPQ 459, (1966).

Clearly, one having ordinary skill in the art would not have been led to modify the applied prior art to arrive at the claimed invention, since to do so would be contrary to the applied arts own explicit teachings and would render the applied art unable to accomplish its stated purpose. Thus, there is no teaching, suggestion or inference in the prior art as a whole, which could possibly led to the proposed modifications.

The only basis one would have to modify the applied art as proposed by the Examiner, is the Applicants' disclosure. Thus, the rejection has made without consideration of all the objective evidence bearing on the issue of obviousness, and whether one having ordinary skill in the art would have found the claimed invention, as a whole, obvious.

In this particular case, the Examiner has apparently failed to recognize the fact that the prior art could not be modified so as to result in the combination defined by the claims, without contradicting the applied art's own teachings and rendering it unable to meet its primary objective. The prior art not only fails to suggest the desirability of the Examiner's proposed modification, but in fact teaches against them. Thus, the applied art would not have made the proposed modification obvious (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986) and In re Fritch, 23 USPQ 1780 (Fed. Circ. 1992)).

Unquestionably, the prior art did not make obvious the invention, as a whole, for which patentability is claimed. The Examiner has not even established that each claimed element is found somewhere in the applied prior art, let alone that the invention

as a whole is obvious (See Hartness International, Inc. v Simplimatic Engineering Co., 2 USPQ 2d 1826 (Fed. Circ. 1987)).

The record in this case establishes that the Examiner has opted to rely on simplicity and hindsight rather than the proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). Based on the objective evidence, there is no possibility that the applied prior art could be modified so as to result in the combination defined by the claims. Furthermore, there is no objective basis which could support a conclusion that the applied prior art would have made the proposed modifications desirable or obvious, since the proposed modifications are inconsistent with the prior art's own teachings and stated purpose. Since any such suggestion of the proposed modification is absent, the basis for the rejection can only be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

Even if the applied prior art could be modified so as to result in the combination defined by the claims (which it is respectfully submitted is not the case, as evidenced above), the applied prior art itself expressly teaches against the Examiner's proposed modification, and therefore also teaches that such modifications are undesirable and would not have been obvious (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and In re Keller, 208 USPQ 817 (CCPA 1981)).

The deficiencies in the applied art here cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sense. (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)).

However, the lack of a prima facie basis for the rejection extends beyond the independent claims. Indeed, numerous other distinguishing features and limitations recited in the respective dependencies of independent claims 1 and 27 are not addressed and have apparently been either completely or effectively ignored during the examination of this application. Such features include those recited in claims 3, 6, 7, 8,

9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 22, 24, 25, 26, 29, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 48, 50, 51, and 52.

Provisional Rejection of Claims 1, 5-10, 27 and 31-36 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

Claims 1, 5-10, 27 and 31-36 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 53-72 of co-pending U.S. Application S/N 09/984,568.

As understood, the rejection is based on the contention that claims 53-72 recite the same system and method as that of the provisionally rejected claims, and are distinguishable only on the basis of an intended use (i.e. the present application being directed to payment and the '568 application being directed to bill presentment).

However, it is respectfully submitted that this is not the case. While it is acknowledged that the Examiner is correct in stating that the intended usages of the inventions are different, recited features and limitations distinguish the present claims from those of the '568 application.

In the Response to Arguments on page 4 of the final Official Action, the Examiner alleges that the applied Thomas patent evidences that it was well known to use the same system and method for both bill payment and bill presentment. However, the Examiner fails to provide any insight into how this might be relevant.

Claim 1 of the present application requires that a payment instruction be transmitted from a first payment service provider to a second payment service provider.

Claim 53 of the '568 application, on the other hand, requires that an activation instruction (not a request for presentment of a bill) be transmitted from the first billing service provider to a second billing service provider.

Even if, for the sake of argument, one were to assume that the payment and billing service providers are the same, one can only ask how could lead one to

conclude that a payment instruction could obviously be an activation instruction or visa versa.

These respective instructions are materially different. The difference in the claims of the present and '568 applications is analogous to, for example, claims in two applications which respectively recite (1) transmitting a message encoded in accordance with a first type encoding for a first purpose from a first entity to a second entity, and (2) transmitting a message encoded in accordance with a second type encoding for a second (i.e. different) purpose from the first entity to the second entity. One cannot properly ignore the difference in the encoding of the messages (i.e. the differences in the messages) in determining whether one claim made obvious the other. Rather, the question, for purposes of obviousness type double patenting, is whether or not the transmittal of the message encoded in accordance with the first type encoding suggests the transmittal of the message encoded in accordance with the second type encoding, or visa versa. If not, the inventions are distinct and therefore not subject to an obviousness type double patenting rejection.

Likewise, contrary to the Examiner's position, in the present instance the differences in the messages cannot simply be ignored. Rather, the question, for purposes of obviousness type double patenting, is whether or not the transmittal of the payment instruction message makes obvious the transmittal of the activation instruction message, or visa versa. If not, the inventions are distinct and therefore not subject to an obviousness type double patenting rejection.

As the Examiner acknowledged that the differences in the messages has been ignored, there can be no prima facie basis for the obviousness type double patenting rejection.

Furthermore, with regard to claims 5-10, 27 and 31-36, no support whatsoever has been presented for the obviousness-type double patenting rejection. Here again, the rejection is argued in omnibus fashion, and not on a claim-by-claim basis.



### 3. THERE IS NO MOTIVATION TO MODIFY THE ART AS PROPOSED BY THE EXAMINER

It is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to modify references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 148 USPQ 459 (1966), **and** to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985). Such a reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984); In re Semaker, 217 USPQ 1 (Fed. Cir. 1983).

Clearly, one having ordinary skill in the art would not have been led to modify the applied prior art to arrive at the claimed invention, since (as detailed above) to do so would be contrary to the applied arts own explicit teachings and would render the applied art unable to accomplish its stated purpose. Thus, there is no teaching, suggestion or inference in the prior art as a whole, which could possibly led to the proposed modifications.

The only basis one would have to modify the applied art as proposed by the Examiner, is the Applicants' disclosure. Thus, the rejection has made without consideration of all the objective evidence bearing on the issue of obviousness, and whether one having ordinary skill in the art would have found the claimed invention, as a

whole, obvious.

In this particular case, the Examiner has apparently failed to recognize the fact that the prior art could not be modified so as to result in the combination defined by the claims, without contradicting the applied art's own teachings and rendering it unable to meet its primary objective. The prior art not only fails to suggest the desirability of the Examiner's proposed modification, but in fact teaches against them. Thus, the applied art would not have made the proposed modification obvious (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986) and In re Fritch, 23 USPQ 1780 (Fed. Circ. 1992)).

#### 4. THE APPLIED REFERENCE FAILS TO SUGGEST THE CLAIMED INVENTION

In rejecting claims under 35 U.S.C. 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 154 USPQ 173 (CCPA 1967). It also is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 148 USPQ 459 (1966), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985).

Such a reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 217 USPQ 1 (Fed.

Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 212 USPQ 323 (CCPA 1981); In re Wilding, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Hartness Int'l, Inc. v. Simplimatic Eng'g Co., 2 USPQ2d 1826 (Fed. Cir. 1987). It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 125 USPQ 328 (CCPA 1960).

The fact that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 230 USPQ 313 (Fed. Cir. 1986). The test is what the combined teachings would have suggested to those of ordinary skill in the art. In re Keller, 208 USPQ 817 (CCPA 1981). Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, supra. Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common

sensible.

The proper approach to the issue of obviousness is whether the hypothetical person of ordinary skill in the art, familiar with the references, would have found it obvious to make a structure corresponding to what is claimed. In re Keller, 208 USPQ 871 (CCPA 1981); In re Semaker, 217 USPQ 1 (Fed. Cir. 1983). Hindsight obviousness after the invention has been made is not the test. In re Carroll, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 108 USPQ 326 (CCPA 1956); In re Skoll, 187 USPQ 481 (CCPA 1975).

Again, the issue is not whether it is within the skill of the artisan to make the proposed modification but, rather, whether a person of ordinary skill in the art, upon consideration of the references, would have found it obvious to do so. The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984), In re Deminski, 230 USPQ 313 (Fed. Cir. 1986), In re Keller, supra. and In re Laskowski, 10 USPQ2d 1397 (CAFC 1989).

As discussed above in detail, the applied prior art fails to teach or suggest the limitation of independent claim 1 that information indicating that the payee is associated with the second payment network is received [implicitly by the first payment service provider (see below)], and it appears that this limitation has been completely ignored.

According to claim 1, a payment instruction from the first payment service provider is also transmitted to the second payment service provider to make the payment to the payee. Implicit in this recital is (i) that the transmittal of the payment instruction from the first payment service provider occurs after the information, which indicates that the payee is associated with the second payment network, is received, and (ii) that the information indicating that the payee is associated with the second

payment network be received by the first payment service provider. Otherwise, the identity of the payee's payment service provider would be unknown to the first payment service provider. Here too, as discussed above in detail, the applied prior art fails to teach or suggest the recited limitation, and it again appears that this limitation has been completely ignored. Additionally, the application of Thomas as proposed is inconsistent with Thomas' own explicit teachings and would render Thomas unable to accomplish its primary objective.

Independent claim 27 is directed to a system for making payments across multiple payment networks including a first payment network having a plurality of associated payers and payees, and a second payment network having a plurality of associated payers and payees. The system includes a first payment processing station associated with the first payment network configured to:

- 1) receive a request to make a payment on behalf of a payer to a payee not associated with the first payment network,
- 2) to transmit a request to determine a payment network within the multiple payment networks with which the payee is associated,
- 3) to receive information indicating that the payee is associated with the second payment network, and
- 4) to transmit a payment instruction to the second payment network to make the payment to the payee.

As has been discussed in detail above, Thomas lacks any teaching or suggestion of the payer bank receiving information indicating that the payee is associated with the payee or second bank (or a second payment network), or transmitting a payment instruction to the payee bank (or a second payment network) to make the payment to the payee. In fact, providing the first payment processing station required by claim 27 would be inconsistent with Thomas' teaching and render Thomas unable to meet its primary objective.

The claim 27 system also includes a second payment processing station associated with the second payment network which is configured to receive the transmitted payment instruction.

Here again, as has been discussed in detail above, Thomas lacks any teaching or suggestion of the payee bank receiving a payment instruction transmitted by the payer bank. Since this would require that information be made available to the payer bank, which Thomas explicitly teaches should not be made available to the payer bank, having the second payment processing station required by claim 27 would also be inconsistent with Thomas' teaching and render Thomas unable to meet its primary objective.

It is further respectfully submitted that the Examiner has failed to identify any teaching or suggestion, and the applied prior art lacks any teaching or suggestion within its teachings, of the features and limitations recited, for example, in dependent claims 3, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 22, 24, 25, 26, 29, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 48, 50, 51, and 52, which further distinguish over the applied prior art. Indeed, it appears that the Examiner has not even examined these claims.

For example, claim 3 requires that the information received by the first payment service provider, which indicates that the payee is associated with the second payment network, be stored with a received unique identifier. A second request to make a second payment to the payee is received at the first payment service provider. The stored information indicating that the payee is associated with the second payment network is retrieved and a second payment instruction, including the retrieved unique identifier, is transmitted from the first payment service provider to the second payment service provider to make the second payment to the payee. Claim 29 has similarly distinguishing limitations.

Claim 6 requires that one or more of the multiple payment networks be identified

as candidate payment networks with which the payee may be associated, based upon the transmitted request. The inter-network directory provider transmits information indicating the one or more identified candidate payment networks to the first payment service provider. Claim 32 has similarly distinguishing limitations.

Claim 7 requires that a request to the second payment service provider be transmitted to determine if the payee is associated with the second payment network. Also required is that the received information, indicating that the payee is associated with the second payment network, be received from the second payment service provider in response to the transmitted request to determine if the payee is associated with the second payment network. Claim 33 has similar distinguishing limitations.

Claim 8 requires that the received information indicating that the payee is associated with the second payment network includes information identifying the payee as one candidate payee and at least one other payee as another candidate payee associated with the second payment network. The second payment service provider identifies the payee as a candidate payee and the at least one other payee as another candidate payee, based upon the received request. Prior to transmitting the payment instruction, it is determined that the one candidate payee, and not the at least one other candidate payee, is the payee based upon at least one of 1) information included in the request transmitted to the second payment service provider, and 2) the received information identifying the one and the at least one other candidate payees. Claim 34 has similarly distinguishing limitations.

Claim 9 requires that the payer is associated with the first payment network, the request to make a payment on behalf of the payer is received from the payer, and the determination that the one candidate payee is the payee is made by the payer. The received information identifying the one and the at least one other candidate payees is transmitted to the payer. The determination that the one candidate payee is the payee, is received from the payer at the first payment service provider. Claim 35 has similarly

distinguishing limitations.

Claim 10 requires that the determination that the one candidate payee is the payee is made by the first payment service provider. Claim 36 has similarly distinguishing limitations.

Claim 11 requires that a request is transmitted to a third payment service provider associated with the third payment network to determine if the payee is associated with the third payment service network. The payee is determined not to be associated with the third payment service network responsive to the request to the third payment service provider, and the result of this determination is transmitted by the third payment service provider to the first payment service provider. Claim 37 has similarly distinguishing limitations.

Claim 12 requires that the received information from the inter-network directory provider include information indicating that the second payment service provider requires secured communications. A certificate authority is accessed to retrieve an encryption key associated with the second payment service provider. The request transmitted to the second payment service provider is encrypted with the encryption key prior to transmission of the request. Claim 38 has similarly distinguishing limitations.

Claim 13 requires that the received information indicating that the payee is associated with the second payment network is a positive declaration that the payee is associated with the second payment network. Claim 39 has similarly distinguishing limitations.

Claim 14 recites that the inter-network directory provider stores information associated with each of the multiple payment networks and information indicating a network path over which to communicate with a certificate authority. Claim 40 has similarly distinguishing limitations.

Claim 15 requires that the information stored by the inter-network directory provider is accessed and searched by the first payment service provider. Claim 41 has



similarly distinguishing limitations.

Claim 16 requires that the information stored by the inter-network directory provider is downloaded and searched by the first payment service provider. Claim 42 has similarly distinguishing limitations.

Claim 17 recites that the received information indicating that the payee is associated with the second payment network is received from the inter-network directory provider and is a positive determination that the payee is associated with the second payment network. Claim 43 has similarly distinguishing limitations.

Claim 18 recites that the request to determine the payment network with which the payee is associated is transmitted to the second payment service provider, and the received information indicating that the payee is associated with the second payment network is received from the second payment service provider. Claim 44 has similarly distinguishing limitations.

Claim 19 requires that the request to make the payment on behalf of the payer is received from a third payment service provider, and that the payer and the third payment service provider are associated with a third payment network. Claim 45 has similarly distinguishing limitations.

Claim 22 requires that funds from an account associated with the payer be transferred to an account associated with the first payment service provider. Funds from an account associated with the first payment service provider are transferred to an account associated with the second payment service provider. Funds from an account associated with the second payment service provider are transferred to an account associated with the payee. Claim 48 has similarly distinguishing limitations.

Claim 24 recites that remittance advice associated with the payment is transmitted from the first payment service provider to the second payment service provider, and that this remittance advice is transmitted from the second payment service provider to the payee. Claim 50 has similarly distinguishing limitations.

Claim 25 recites that the remittance advice transmitted from first payment service provider to the second payment service provider is structured according to a first message set, and that the remittance advice transmitted from the second payment service provider to the payee is structured according to a second message set different than the first message set. Claim 51 has similarly distinguishing limitations.

Claim 26 requires that a determination be made at the second payment service provider, as to whether the payment instruction will be accepted, and that the results of the determination be transmitted to the first payment service provider and from the first payment service provider to the payer. Claim 52 has similarly distinguishing limitations.

Unquestionably, the prior art did not make obvious the invention, as a whole, for which patentability is claimed. The Examiner has not even established that each claimed element is found somewhere in the applied prior art, let alone that the invention as a whole is obvious (See *Hartness International, Inc. v Simplimatic Engineering Co.*, (2 USPQ 2d 1826 (Fed. Circ. 1987))).

Even if the applied prior art could be modified so as to result in the combination defined by the claims (which it is respectfully submitted is not the case, as evidenced above), the applied prior art itself expressly teaches against the Examiner's proposed modification, and therefore also teaches that such modifications are undesirable and would not have been obvious (See *In re Gordon* 221 USPQ 1125 (Fed. Circ. 1984), and *In re Keller*, 208 USPQ 817 (CCPA 1981)).

The deficiencies in the applied art here cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sense. (See *In re Lee*, 61 USPQ 2d 1430 (Fed. Circ. 2002)).

#### 5. THE APPLIED CO-PENDING APPLICATION FAILS TO SUGGEST THE CLAIMED INVENTION

Claims 1, 5-10, 27 and 31-36 stood provisionally rejected under the judicially

created doctrine of obviousness-type double patenting over claims 53-72 of co-pending U.S. Application S/N 09/984,568

As detailed above, contrary to the Examiner's position, the differences in the messages claimed in the rejected claims of the present application and those of the referenced claims of the applied '568 application cannot simply be ignored. Rather, the question, for purposes of obviousness type double patenting, is whether or not the transmittal of the payment instruction message makes obvious the transmittal of the activation instruction message, or visa versa. If not, the inventions are distinct and therefore not subject to an obviousness type double patenting rejection.

In this regard, while the recited methods of the present and '568 applications are related, they can be (and often are) performed independently. That is, there is no requirement that electronic bill payment always be performed in conjunction with electronic bill presentment, or that electronic bill presentment always be performed in conjunction with electronic bill payment.

Furthermore, to support obviousness type double patenting of claim 1 of the present application, one must conclude that the transmittal of the payment instruction message of claim 1 of the present application suggests the transmittal of the activation instruction message of the cited claims of the '568 application, or that the transmittal of the activation instruction message of the cited claims of the '568 application suggests the transmittal of the payment instruction message of claim 1 of the present application. It is respectfully submitted that there is no such suggestion, and the Examiner has failed to provide any support for a contrary conclusion.

First, the issuance of a payment instruction to pay a bill, on its face, lacks any suggestion of issuing an activation instruction to activate a biller to electronically present a bill, and visa versa.

Additionally, in the case of payment, there is no need to issue an activation instruction to activate a biller, because a biller can be electronically paid by the payer

without ever being “activated” by a service provider to electronically receive bill payments from the payer. Also, in the case of payment, there is no need for the payer to receive an electronic bill to make an electronic payment, because a payment instruction can be issued to pay the biller without the biller ever providing an electronic bill to the payer (in fact this remains the case in many electronic payments today).

Furthermore, in the case of bill presentment, there is no need to issue a payment instruction to pay the biller, because the biller can be “activated” for electronic presentment of a payer’s bill by a service provider without the biller ever receiving an electronic payment from the payer. Further still, in the case of bill presentment, there is no need to issue any instructions to the biller’s service provider (i.e. the second billing service provider) once the biller has been activated, because after activation the payer’s bills will be made available at the payer’s service provider (i.e. the first billing service provider) for electronic presentation to the payer.

Hence, contrary the unsupported conclusion asserted in the final Official Action, claim 1 of the present application and claim 53 of the ‘568 application respectively recite unobvious limitations, and hence different (i.e. distinct) methods.

No support whatsoever has been provided for the obviousness-type double patenting rejection of claims 5-10, 27 and 31-36. It is respectfully submitted other features distinguish these claims from those cited in the ‘568 application. However, since these claims are not argued on a claim-by-claim basis in the final Official Action, it would appear unnecessary to individually discuss them herein.

6. THE REJECTION IS BASED EITHER ON AN IMPROPER HINDSIGHT  
RECONSTRUCTION OF THE INVENTION BASED ON THE APPLICATIONS OWN  
TEACHINGS OR ON PURE SPECULATION

Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and

not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F2d 1392, 187 USPQ 481 (CCPA 1975).

Inherency requires certainty, not speculation. In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 212 USPQ 323 (CCPA 1981); In re Wilding, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

As discussed above, the record in this case establishes that the Examiner has opted to rely on simplicity and hindsight rather than the proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). Based on the objective evidence, there is no possibility that the applied prior art could be modified so as to result in the combination defined by the claims. Furthermore, there is no objective basis which could support a conclusion that the applied prior art would have made the proposed modifications desirable or obvious, since the proposed modifications are inconsistent with the prior art's own teachings and stated purpose. Since any such suggestion of the proposed modification is absent, the basis for the rejection can only be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

The appealed claims have been rejected without objective factual support or rational. The art cited in support of the rejections has been applied in a manner

inconsistent with its own teachings. Modifications to the applied art have been proposed for which no motivation exist. Express limitations set forth in the claims have been completely or effectively ignored.

The evidence shows that there is nothing in the applied art to support the Examiner's position that the present claims are obvious. Hence, at best, it can only be concluded that the rejection of the claims, as set out in the final Official Action, reflects an improper hindsight reconstruct the invention using the inventors own disclosure, or reliance on pure speculation.

### **CONCLUSION**

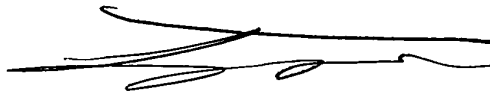
It is respectfully submitted that the Examiner (i) has denied applicants their due process rights under the Constitution of the United States of America, (ii) has failed to establish a prima facie case for the rejection, (iii) has proposed to modify the applied art in a manner which is unmotivated, (iv) has failed to apply art which teaches or suggests the claimed invention, and (v) has, at best, attempted to improper reconstruct the invention using the inventors own disclosure or relied on pure speculation in rejecting the claims. Thus, the rejection of the pending claims over the applied prior art, whether taken individually or in any combination, is improper.

In summary, Applicants respectfully submit that the applied references do not teach or suggest features recited in each of the rejected independent claims, as well as features recited in the dependent claims, and the Examiner has failed provided reasonable evidence to support a contrary conclusion. Furthermore, the proposed modifications to the applied references are themselves unmotivated and therefore improper. Accordingly, it is submitted that the art does not provide any teaching, or suggestion within its teachings, which would lead to the features or advantages of the instant invention, and the claims patentably define over the art. The rejections can therefore only be based on an improper hindsight reconstruction or pure speculation. Thus, the rejection of the pending claims is

in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,  
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**APPENDIX OF CLAIMS UNDER APPEAL**

1. (original) A method for making payments across multiple payment networks including a first payment network having a first payment service provider and a plurality of associated payers and payees, and a second payment network having a second payment service provider and a plurality of associated payers and payees, comprising:

receiving, at a first payment service provider, a request to make a payment on behalf of a payer to a payee not associated with the first payment network;

transmitting a request of the first payment service provider to determine a payment network within the multiple payment networks with which the payee is associated;

receiving information indicating that the payee is associated with the second payment network; and

transmitting a payment instruction from the first payment service provider to the second payment service provider to make the payment to the payee.

2. (original) The method of claim 1, wherein:

the received information includes a unique identifier which identifies the payee to the second payment service provider; and

the transmitted payment instruction includes the unique identifier.



3. (original) The method of claim 2, wherein the request to make a payment on behalf of the payer to the payee is a first request to make a first payment to the payee, and the payment instruction is a first payment instruction, and further comprising:

storing the received information indicating that the payee is associated with the second payment network, the stored information including the received unique identifier;

receiving, at the first payment service provider, a second request to make a second payment to the payee;

retrieving the stored information indicating that the payee is associated with the second payment network;

transmitting a second payment instruction, including the retrieved unique identifier, from the first payment service provider to the second payment service provider to make the second payment to the payee.

4. (original) The method of claim 3, wherein:

the first request is a request to make a payment on behalf of a first payer; and

the second request is a request to make a payment on behalf of one of the first payer or a second payer.

5. (original) The method of claim 1, wherein:

the request to determine a payment network is transmitted to an inter-network directory provider.

6. (original) The method of claim 5, further comprising:

identifying one or more of the multiple payment networks as candidate payment networks with which the payee may be associated based upon the transmitted request;

transmitting information, by the inter-network directory provider, indicating the one or more identified candidate payment networks to the first payment service provider;

wherein the transmitted information indicating the one or more identified candidate payment networks includes information identifying the second payment network as a candidate payment network.

7. (original) The method of claim 6, further comprising:

transmitting a request to the second payment service provider to determine if the payee is associated with the second payment network;

wherein the received information indicating that the payee is associated with the second payment network is received from the second payment service provider in response to the transmitted request to determine if the payee is associated with the second payment network.

8. (original) The method of claim 7, wherein the received information indicating that the payee is associated with the second payment network includes information

identifying the payee as one candidate payee and at least one other payee as another candidate payee associated with the second payment network, and further comprising:

identifying, by the second payment service provider, the payee as a candidate payee and the at least one other payee as another candidate payee based upon the received request; and

determining, prior to transmitting the payment instruction, that the one candidate payee, and not the at least one other candidate payee, is the payee based upon at least one of 1) information included in the request transmitted to the second payment service provider, and 2) received information identifying the one and the at least one other candidate payees.

9. (original) The method of claim 8, wherein the payer is associated with the first payment network, the request to make a payment on behalf of the payer is received from the payer, and the determination that the one candidate payee is the payee is made by the payer, further comprising:

transmitting the received information identifying the one and the at least one other candidate payees to the payer; and

receiving, at the first payment service provider, the determination that the one candidate payee is the payee from the payer.

10. (previously amended) The method of claim 8, wherein the determination that the

one candidate payee is the payee is made by the first payment service provider.

11. (original) The method of claim 7, wherein the received information from the inter-network directory provider further includes information identifying a third payment network as a candidate payment network, and further comprising:

transmitting a request to a third payment service provider associated with the third payment network to determine if the payee is associated with the third payment service network;

determining that the payee is not associated with the third payment service network responsive to the request to the third payment service provider; and

transmitting the result of the determination by the third payment service provider to the first payment service provider.

12. (original) The method of claim 7, wherein the received information from the inter-network directory provider includes information indicating that the second payment service provider requires secured communications, further comprising:

accessing a certificate authority to retrieve an encryption key associated with the second payment service provider; and

encrypting the request transmitted to the second payment service provider with the encryption key prior to transmission of the request.

13. (original) The method of claim 7, wherein the received information indicating that the payee is associated with the second payment network is a positive declaration that the payee is associated with the second payment network.

14. (original) The method of claim 5, wherein:

the inter-network directory provider stores information associated with each of the multiple payment networks and information indicating a network path over which to communicate with a certificate authority; and

the information associated with each of the multiple payment networks includes at least one of 1) information indicating a country in which a payment service provider associated with that payment service network is located, 2) information identifying a network path over which to communicate with the associated payment service provider, 3) information indicating types of financial transactions supported by the associated payment service provider, 4) information indicating secured communications requirements of the associated payment service provider, 5) information identifying a treasury service provider associated with the associated payment service provider, 6) information identifying a deposit account associated with the associated payment service provider, 7) information identifying a processing model associated with the associated payment service provider, 8) and information identifying a settlement method associated with the associated payment service provider.

15. (original) The method of claim 14, wherein the information stored by the inter-network directory provider is accessed and searched by the first payment service provider.

16. (original) The method of claim 14, wherein the information stored by the inter-network directory provider is downloaded and searched by the first payment service provider.

17. (original) The method of claim 5, wherein the inter-network directory provider stores information for each of the multiple payment networks indicating associations between its payment service provider and its payees, and the received information indicating that the payee is associated with the second payment network is received from the inter-network directory provider and is a positive determination that the payee is associated with the second payment network, further comprising:

determining, by the inter-network directory provider, the payment network with which the payee is associated based upon the transmitted request and the stored information.

18. (original) The method of claim 1, wherein the request to determine the payment network with which the payee is associated is transmitted to the second payment service provider, and the received information indicating that the payee is associated

with the second payment network is received from the second payment service provider.

19. (original) The method of claim 1, wherein:

the request to make the payment on behalf of the payer is received from a third payment service provider; and

the payer and the third payment service provider are associated with a third payment network.

20. (original) The method of claim 1, wherein the payment is one of a payment of a bill, a payment of an invoice, a gift payment, a person-to-merchant payment, or a person-to-person payment.

21. (original) The method of 1, wherein:

the request to make the payment is structured according to a first message set; and

the request to determine the payment network with which the payee is associated, the information indicating that the payee is associated with the second payment network, and the payment instruction are each structured according to a second message set different than the first message set.

22. (original) The method of claim 1, further comprising:

transferring funds from an account associated with the payer to an account associated with the first payment service provider;

transferring funds from an account associated with the first payment service provider to an account associated with the second payment service provider; and

transferring funds from an account associated with the second payment service provider to an account associated with the payee.

23. (original) The method of claim 22, wherein at least one of 1) the transfer of funds from the account associated with the payer to an account associated with the first payment service provider, 2) the transfer of funds from an account associated with the second payment service provider to the account associated with the payee, and 3) the transfer of funds from an account associated with the first payment service provider to an account associated with the second payment service provider is an electronic funds transfer.

24. (original) The method of claim 1, further comprising:

transmitting remittance advice associated with the payment from the first payment service provider to the second payment service provider; and

transmitting the remittance advice associated with the payment from the second payment service provider to the payee.



25. (original) The method of claim 24, wherein:

the remittance advice transmitted from first payment service provider to the second payment service provider is structured according to a first message set; and  
the remittance advice transmitted from the second payment service provider to the payee is structured according to a second message set different than the first message set.

26. (original) The method of claim 1, further comprising:

determining, at the second payment service provider, if the payment instruction will be accepted;  
transmitting the results of the determination to the first payment service provider;  
and  
transmitting the received results of the determination to the payer.

27. (original) A system for making payments across multiple payment networks including a first payment network having a plurality of associated payers and payees, and a second payment network having a plurality of associated payers and payees, comprising:

a first payment processing station associated with the first payment network configured to 1) receive a request to make a payment on behalf of a payer to a payee

not associated with the first payment network, 2) to transmit a request to determine a payment network within the multiple payment networks with which the payee is associated, 3) to receive information indicating that the payee is associated with the second payment network, and 4) to transmit a payment instruction to the second payment network to make the payment to the payee; and

a second payment processing station associated with the second payment network and configured to receive the transmitted payment instruction.

28. (original) The system of claim 27, wherein:

the received information includes a unique identifier which identifies the payee to the second payment processing station; and

the transmitted payment instruction includes the unique identifier.

29. (original) The system of claim 28, wherein:

the request to make a payment on behalf of the payer to the payee is a first request to make a payment to the payee;

the payment instruction is a first payment instruction;

the first payment processing station is further configured to 1) store the received information indicating that the payee is associated with the second payment network, including the unique identifier, 2) receive a second request to make a second payment to the payee, 3) retrieve the stored information indicating that the payee is associated

with the second payment network, 4) transmit a second payment instruction, including the retrieved unique identifier, to the second payment network; and

the second payment processing station is further configured to receive the second payment instruction.

30. (original) The system of claim 29, wherein:

the first request is a request to make a payment on behalf of a first payer; and

the second request is a request to make a payment on behalf of one of the first payer or a second payer.

31. (original) The system of claim 27, further comprising:

an inter-network directory station configured to receive the transmitted request to determine the payment network with which the payee is associated.



32. (original) The system of claim 31, wherein:

the inter-network directory station is further configured to identify one or more of the multiple payment networks as candidate payment networks with which the payee may be associated based upon the transmitted request, and to transmit information indicating the one or more identified candidate payment networks to the first payment network;

the first payment processing station is further configured to receive the

information indicating the one or more identified candidate payment network; and  
the information indicating the one or more identified candidate payment networks  
includes information identifying the second payment network as a candidate payment  
network.

33. (original) The system of claim 32, wherein:

the first payment processing station is further configured to transmit a request to  
the second payment network to determine if the payee is associated with the second  
payment network; and

the second payment processing station is further configured to receive the  
transmitted request and to transmit the information indicating that the payee is  
associated with the second payment network.

34. (original) The system of claim 33, wherein:

the received information indicating that the payee is associated with the second  
payment network includes information identifying the payee as one candidate payee  
and at least one other payee as another candidate payee associated with the second  
payment network;

the second payment processing station is further configured to identify the payee  
as a candidate payee and the at least one other payee as another candidate payee  
based upon the received request, and to transmit the information identifying the one

candidate payee and the at least one other candidate payee to the first payment network; and

the first payment processing station is further configured to receive the transmitted information identifying the one candidate payee and the at least one other candidate payee.

35. (original) The system of claim 34, further comprising:

a payer network station associated with the first payment network and configured to transmit, via the network, the payment request to the first payment processing station;

wherein the first payment processing station is further configured to transmit, via the network, the received information identifying the one candidate payee and the at least one other candidate payee to the payer network station;

wherein the payer network station is further configured to receive the transmitted information and to transmit a payer selection of the payee from the information identifying the one candidate payee and the at least one other candidate payee to the first payment processing station.

36. (original) The system of claim 34, wherein:

the first payment processing station is further configured to determine, prior to transmitting the payment instruction, that the one candidate payee, and not the at least

one other candidate payee, is the payee based upon at least one of 1) information included in the request transmitted to the second payment processing station, and 2) the received information identifying the one and the at least one other candidate payees.

37. (original) The system of claim 33, wherein the received information from the inter-network directory station further includes information identifying a third payment network as a candidate payment network, further comprising:

a third payment processing station associated with the third payment network;

wherein the first payment processing station is further configured to transmit a request to the third payment network to determine if the payee is associated with the third payment network and to receive results of the determination of if the payee is associated with the third payment network;

wherein the third payment processing station is configured to receive the request transmitted to the third payment network, to determine if the payee is associated with the third payment network, and to transmit, the results of the determination; and

wherein the results of the determination are that the payee is not associated with the third payment network.

38. (original) The system of claim 33, further comprising:

a certificate authority configured to store a plurality of encryption keys, each

associated with one of a plurality of payment processing stations;

wherein the information received from the inter-network directory station includes information indicating that the second payment processing station requires secured communications;

wherein the first payment processing station is further configured to access the certificate authority to retrieve an encryption key associated with the second payment processing station and to encrypt the request with the encryption key prior to transmission of the request.

39. (original) The system of claim 33, wherein:

the received information indicating that the payee is associated with the second payment network is a positive declaration that the payee is associated with the second payment network.

40. (original) The system of claim 31, wherein:

the inter-network directory station is further configured to store information associated with each of the multiple payment networks and information indicating a network path over which to communicate with a certificate authority;

the information associated with each of the multiple payment networks includes at least one of 1) information indicating a country in which a payment processing station associated with that payment network is located, 2) information identifying a network

path over which to communicate with the associated payment processing station, 3) information indicating types of financial transactions supported by the associated payment processing station, 4) information indicating secured communications requirements of the associated payment processing station, 5) information identifying a treasury service provider associated with the associated payment processing station, 6) information identifying a deposit account associated with the associated payment processing station, 7) information identifying a processing model associated with the associated payment processing station, 8) and information identifying a settlement method associated with the associated payment processing station.

41. (original) The system of claim 40, wherein:

the inter-network directory station is further configured such that the stored information is accessed and searched by the first payment processing station.

42. (original) The system of claim 40, wherein:

the inter-network directory station is further configured such that the stored information is downloaded and searched by the first payment processing station.

43. (original) The system of claim 31, wherein:

the received information indicating that the payee is associated with the second payment network is received from the inter-network directory station and is a positive



determination that the payee is associated with the second payment network; and  
the inter-network directory station is further configured to store information for each of the multiple payment networks indicating associations between its payment processing station and its payees, and to determine the payment network with which the payee is associated based upon the transmitted request and the stored information.

44. (original) The system of claim 27, wherein:

the request to determine the payment network with which the payee is associated is transmitted to the second payment network;

the received information indicating that the payee is associated with the second payment network is received from the second payment processing station;

the second payment processing station is further configured to determine if the payee is associated with the second payment network based upon the received request.

45. (original) The system of claim 27, further comprising:

a third payment processing station associated with a third payment network;  
wherein the request to make a payment on behalf of the payer is received from the third payment processing station; and  
the payer is associated with the third payment network.

46. (original) The system of claim 27, wherein the payment is one of a payment of a bill, a payment of an invoice, a gift payment, a person-to-merchant, or a person-to-person payment.

47. (original) The system of 27, wherein:

the request to make the payment is structured according to a first message set;

the request to determine the payment network with which the payee is associated, the information indicating that the payee is associated with the second payment network, and the payment instruction are each structured according to a second message set different than the first message set.

48. (original) The system of claim 27, wherein:

the first payment processing station is further configured to cause funds to be transferred from an account associated with the payer to an account associated with the first payment processing station and to cause funds to be transferred from an account associated with the first payment processing station to an account associated with the second payment processing station; and

the second payment processing station is further configured to cause funds to be transferred from an account associated with the second payment processing station to an account associated with the payee.

49. (original) The system of claim 48, wherein and least one of 1) the transfer of funds from the account associated with the payer to an account associated with the first payment processing station, 2) the transfer of funds from an account associated with the first payment processing station to an account associated with the second payment processing station, and 3) the transfer of funds from an account associated with the second payment processing station to the account associated with the payee is an electronic funds transfer.

50. (original) The system of claim 27, further comprising:

a payee network station associated with the second payment network;

wherein the first payment processing station is further configured to transmit remittance advice associated with the payment to the second payment network; and

wherein the second payment processing station is further configured to receive the transmitted remittance advice and to further transmit the remittance advice to the payee network station.

51. (original) The method of claim 50, wherein:

the remittance advice transmitted from first payment processing station to the second payment network is structured according to a first message set; and

the remittance advice transmitted from the second payment processing station to the payee network station is structured according to a second message set different

than the first message set.

52. (original) The method of claim 27, wherein:

the second payment processing station is further configured to determine if the payment instruction will be accepted for execution, and to transmit the results of the determination to the first payment network; and

the first payment processing station is further configured to receive transmitted results and to propagate the results to the payer.